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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/073,486
Filing Date: February 11, 2002
Appellant(s): MARTIN ET AL.

Joseph M. Butscher
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 15, 2007 appealing from the Office action mailed August 23, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,163,817	SHTEYN et al.	12-2000
5,971,397	MIGUEL et al.	10-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5-8, 10, 11, 13, 14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shteyn et al. (hereinafter Shteyn), US 6,163,817.

1. Shteyn discloses an entertainment system comprising: multiple electronic sub-systems; and a single control subsystem coupled to the electronic subsystems, the control subsystem and the electronic subsystems providing functionality, the control subsystem exercising control over the electronic subsystems (columns 3-6; fig 1 and associated text). Shteyn does not explicitly disclose a game subsystem. However, Shteyn teaches that any electronic subsystem, including a jukebox or any software application can be coupled to a control subsystem (column 2, lines 34-column 4, line 67). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine any electronic subsystem with a control subsystem as taught by Shteyn in order to interconnect, coordinate and control the functionality of multiple devices and/or applications providing more efficiency in a multi-user environment (column 6, lines 9-41).

2. Shteyn further discloses the entertainment system of claim 1, wherein the control system is responsive to at least one mode determining switch for specifying a mode of operation for said entertainment system (columns 4-6).

3. Shteyn further discloses the entertainment system of claim 1, wherein the control subsystem comprises a central processor for controlling operation of the game subsystem and the jukebox subsystem apparatus (column 3-5).

5. Shteyn further discloses the entertainment system of claim 3, further comprising a data storage device coupled to said central processor, said data storage device storing digitized songs for the jukebox subsystem (column 4).

6. Shteyn further discloses the entertainment system of claim 3, wherein the central processor is operative to play audio data streamed from a remote server while providing jukebox functionality (columns 4, 6).

7. Shteyn further discloses the entertainment system of claim 3, further comprising a communication interface for communicating with devices external to the entertainment system (column 3-4).

8. Shteyn further discloses the entertainment system of claim 1, wherein the jukebox subsystem

comprises an audio data decoder, an amplifier, and at least one speaker (columns 3-4).

10. Shteyn further discloses the entertainment system of claim 1, wherein the jukebox subsystem includes a jukebox interface physically separated from the entertainment system for allowing players to interact with the jukebox subsystem while other players interact with the game subsystem (column 6).

Claims 11, 13, 14, 16 and 17 are directed to a method of the system claims above and are rejected accordingly.

Claims 4, 9, 12, 15 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shteyn et al. (hereinafter Shteyn), US 6,163,817 in view of Miguel et al. (hereinafter Miguel), US 5,971,397.

As per claims 4, 9, 12 and 15, Shteyn discloses a method and system for providing an entertainment system having combination functionality, the method comprising: operating in a current mode of operation corresponding to one of a jukebox mode, and another electronic subsystem mode; receiving a mode command; and determining a next mode of operation based on the mode command, the next mode of operation corresponding to one of an electronic subsystem and a jukebox mode (columns 4-6). Although Shteyn discloses any electronic software application or device, it does not explicitly disclose a dart game.

Miguel, however, teaches an automated system for electronic dart machines configured to control various other electronic functionalities (column 3). It would have been obvious for one of ordinary skill in the art at the time of Appellant's invention to incorporate Miguel's electronic dart game functionality as an electronic subsystem as disclosed in Shteyn, in order to minimize the overall number of system components necessary to provide entertainment.

As per claims 18-20, Shteyn discloses a method and system for providing an entertainment system having combined functionality, the method comprising: operating in a current mode of operation corresponding to one of at least two electronic subsystems; receiving a mode command; and determining a next mode of operation based on the mode command, the next mode of operation corresponding to one of a game mode and a jukebox mode (columns 4-6, see rejection above of claim 1). Although Shteyn discloses the use of any electronic subsystem, it does not explicitly disclose at least two electronic subsystems in a single unit housing.

Miguel, however, teaches an automated system for electronic dart machines configured to control various other electronic functionalities (column 3). It would have been obvious for one of ordinary skill in the art at the time of Appellant's invention to incorporate Miguel's electronic dart game functionality as an electronic subsystem as disclosed in Shteyn, in order to minimize the overall number of system components necessary to provide entertainment.

It has been well settled that by providing a single unit or a housing for making integral structures disclosed in the prior art would be merely a matter of obvious engineering choice. *In re Larson*, 144 USPQ 347, 349; 339 US 965 (CCPA 1965); *In re Wolfe*, 116 USPQ 443, 444; 251 F2d 854 (CCPA 1958). It would have been obvious for one of ordinary skill in the art at the time of the invention to include Nathan's game, jukebox and control units in one housing as an

obvious engineering choice in order to minimize use space for the entertainment system which is typically found in entertainment establishments and bars.

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the Appellant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the Appellant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

(10) Response to Argument

I. As per claims 1-3, 5-8, 10, 11, 13, 14, 16 and 17, in response to Appellant's argument that there is no suggestion or motivation to modify Shteyn (6,163,817), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Shteyn discloses the need for "integration of an ever increasing number of possibly interacting functionalities into a single system (column 1, lines 28-30)." Moreover, Shteyn discloses that in entertainment systems for example, a single control means can dynamically control multiple devices and/or subsystems such as a movie player, jukebox, etc. (column 4, lines 4-9). Therefore, it would have

been obvious for one of ordinary skill in the art at the time of the invention to connect another type of electronic device such as a game subsystem to a control means in order to accommodate the "ever increasing number of possibly interacting functionalities" in promoting scalability and efficiency in meeting the demands of the consumer, as per Shteyn (column 1, lines 28-45).

A. Appellant further argues that Shteyn "does not teach or suggest that any electronic subsystem can be used, and certainly does not teach or suggest a game subsystem (response pp. 8-9)." As indicated above, Shteyn does not explicitly disclose a game subsystem. It would be impractical for Shteyn to list every possible electronic device or subsystem that can be coupled to a control subsystem. Rather, Shteyn discloses that any number of electronic subsystems can be interconnected to a control means and provides a few examples of such subsystems (column 3, lines 25-29; column 4, lines 4-9). In fact, Shteyn's invention is directed to interconnecting any electronic device to a control subsystem and the functionalities of the specific devices or the subsystem does not dictate or change the invention.

B. Appellant argues that Shteyn does not inherently disclose a game subsystem (response pp. 9-10). Since the examiner has not relied on the theory of inherency in rejecting the above noted claims, Appellant's argument is immaterial.

II. As per claims 4, 9, 12 15 and 18-20, Appellant argues, "the Office Action speculates that one might obtain a proposed benefit from the proposed combinations ("minimizing the overall number of system components"), the Office Action does not point to anything in these references to this benefit (response pp. 10-12). The examiner respectfully disagrees. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly

suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The primary reference Shteyn provides that a single control means can control the operation and functionality of numerous other electronic devices and subsystems without conflict wherein multiple digital resources can be interrelated and integrated into a single entertainment system (column 1, lines 23-33). The Miguel reference was introduced to demonstrate that it would have been obvious to integrate an electronic dart game as part of the control subsystem as claimed. Miguel discloses that "as the choice of games to play on electronic dart machines has continued to increase, the user interface necessary to permit selection and set-up of those games has become more complicated and burdensome for the player (column 2, lines 37-40)." Therefore, Miguel that teaches that a need exists to control the functionality of a plurality of electronically scored amusement games, including video games, pinball machines, and others (column 3, lines 5-12). Therefore, the teaching of the references as a whole and exemplified portions pointed to above would have lead one of ordinary skill in the art at the time of the invention to combine the references as taught.

III. As per claims 18-20, Appellant further argues that incorporating a game subsystem and jukebox into a single unit is not merely a matter of engineering design choice (response p. 12). Appellant contends that combining electronic entertainment devices and jukeboxes into a single unit is notably patentable since it reduces the number of operating game systems in entertainment establishments, reducing operating costs and need for valuable floor space (response p. 13). The examiner respectfully disagrees. In fact, Shteyn expressly indicates that a "CD jukebox" can be integrated with other electronic devices and subsystems (column 4, lines 5-9). Miguel also

provides that a single unit can house an electronic dart game, cricket, monitor, upper display, IR unit, etc. Moreover, Appellant's argument distinguishing the facts of the established cited case law (In re Larson and Wolf) with the instant claims is without merit.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Bradley Bayat
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